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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Mark E. Marler
Serial Number:	10/501,659
Filed:	July 14, 2004
Group Art Unit:	3654
Examiner:	Kruer, Stefan
Confirmation No.:	2290
Title:	ELEVATOR SYSTEM DESIGN INCLUDING A BELT ASSEMBLY WITH A VIBRATION AND NOISE REDUCING GROOVE CONFIGURATION

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests Pre-Appeal Brief Review of the rejection of claims 23-26 under 35 U.S.C. §103 contained in the Final Office Action mailed on January 19, 2010, because there is no *prima facie* case of obviousness.

Claim 23 is reproduced here for convenience.

> 23. An elevator system, comprising:
> a cab that moves at a contract speed;
> a belt that supports the cab and facilitates movement of the cab, the belt having a plurality of spaced grooves on at least one side of the belt, each of the grooves including a fillet at an edge of each groove; and
> at least one sheave over which the belt travels as the cab moves, the sheave having a diameter that has a relationship to a width of the grooves on the belt so that a ratio of the groove width to the sheave diameter is less than about .015,

> wherein the ratio of the groove width to the sheave diameter is (i) within a first range when the contract speed is above a first speed and (ii) within a second, higher range when the contract speed is a second, slower speed below the first speed.

The Examiner has rejected claims 23-26 under 35 U.S.C. §103 based upon the proposed combination of the *Baranda, et al.*, *Yaginuma* and *Hull* references. The Examiner correctly acknowledges that none of those references teaches or suggests a ratio of a groove width to sheave diameter consistent with that which is recited in Applicant's claim 23. Specifically, none of the references teach a ratio of the groove width to the sheave diameter that is within a first range when the contract speed of the elevator system at which the elevator cab moves is above a first speed and that ratio is within a second, higher range when the contract speed is a second, slower speed below the first speed.

The Examiner contends, "since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art." The Examiner cites *In re: Aller*, 105 USPQ 233, as support for this proposition. That case, however, is inapposite to the analysis of this application. The issue in the *Aller* case was summarized by the Court as follows. "The process of appellants is identical with that of the prior art, except that appellants' claims specify lower temperatures and higher sulfuric acid concentrations than are shown in the reference....The main question involved in this appeal is whether the changes in temperature and in acid concentration amount to invention, or whether such changes would have been obvious to one skilled in the art." That type of analysis does not fit with the analysis in this case.

This is not a case where Applicant has merely changed the contract speed or changed a size of a groove width, for example. Instead, Applicant's claimed invention involves an all new approach to establishing a ratio of a groove width for a groove on a belt supporting an elevator cab and a sheave diameter over which the belt travels as the cab moves. Specifically, that ratio is within one range or another depending upon the contract speed for movement of the elevator cab. There is nothing in any of the references that in any way corresponds to establishing a ratio in that manner.

It follows that the analysis of *Aller* does not help the Examiner in this case. In the *Aller* case, the process of the claims and the prior art were "identical," but in this case there is nothing in the art corresponding to the claimed ratio relationships. The *Aller* case cannot be used to create a claimed limitation that is completely missing from the art for purposes of attempting to manufacture a *prima facie* case of obviousness. There is no basis for the Examiner's conclusion because there is no teaching in any of the references regarding establishing a ratio as recited in Applicant's claims.

Cases such as the *Aller* case in which there is merely one change in a parameter or value compared to the parameters or values that are shown in the art do not apply to cases like this where an entire limitation of Applicant's claims is completely missing from the references relied upon by the Examiner. The concept of using different ratios for different contract speeds is nowhere in the references relied upon by the Examiner. Even if the proposed combination were made, there is not enough to establish a *prima facie* case of obviousness. This is not a case of "discovering an optimum or workable range" but instead, is a situation in which the Examiner has not found an entire portion of

Applicant's claims within the art. There is no *prima facie* case of obviousness and the rejection must be withdrawn.

Respectfully submitted,

CARLSON, GASKEY & OLDS

By: _____

David J. Gaskey
Registration No. 37,139
400 W. Maple Rd., Ste. 350
Birmingham, MI 48009
(248) 988-8360

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